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OF THE TTAB**

*Decision Mailed:
August 28, 2008
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ectribution, Inc.

Serial No. 77340762

Richard S. Ross, Esq. for Ectribution, Inc.

Linda M. King, Trademark Examining Attorney, Law Office 116
(Michael W. Baird, Managing Attorney).

Before Hohein, Walters and Walsh, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Ectribution, Inc. has filed an application to register
on the Principal Register the mark "templates.com" and design, as
reproduced below,



for "on-line retail store services featuring downloadable
software for website development comprising pre-formatted

modifiable templates" in International Class 35 and "website development [services] for others" in International Class 42.¹

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's refusal to comply with a requirement for a disclaimer of the term "templates.com," which the Examining Attorney maintains is merely descriptive of applicant's services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore must be disclaimed apart from the mark as shown.

Applicant has appealed and briefs have been filed. We affirm the disclaimer requirement.

As a preliminary matter, we note that applicant does not argue or otherwise disagree with the Examining Attorney's finding that the term "templates.com" is merely descriptive of applicant's services. In this regard, we concur with the Examining Attorney that, as stated in her brief:

Clearly, the term TEMPLATES describes a feature of the services identified and shown in the Applicant's website offering the

¹ Ser. No. 77340762, filed on November 30, 2007, which is based on an allegation of a bona fide intention to use such mark in commerce. The mark, including a claim as to color, is described as follows:

The mark consists of the word TEMPLATES with each letter separately encased in a colored rectangle, as follows: the first occasion of the letter "t" is in green, as is the letter "l"; the first occasion of the letter "e," the letter "a" and the letter "s" are in blue; the letter "m" and the second occasion of the letter "t" are in red; the letter "p" and the second occasion of the letter "e" are in orange; and ".com" is in gray and not surrounded in a colored rectangle.

The color(s) green, blue, red, orange and gray is/are claimed as a feature of the mark.

services. The services constitute the sale of "pre-formatted modifiable templates" which are also used in the website development services. Consequently, the term TEMPLATES is at least highly descriptive of the services.

Furthermore, the generic top-level domain (TLD) ".com" merely indicates an Internet address for use by commercial, for-profit organizations and, in general, adds no source identifying significance. *E.g., In re Oppendahl & Larsen LLP*, 373 F.3d 1171, 1175-76, 71 USPQ2d 1370, 1373-74 (Fed. Cir. 2004); *In re Martin Container, Inc.*, 65 USPQ2d 1058, 1060-61 (TTAB 2002); see TMEP §§1209.03(m) [and] 1215.01.

Consequently, the entire term TEMPLATES.COM is [merely] descriptive of the services.

Applicant, instead, contends that its mark is unitary and, in view thereof, a disclaimer of the merely descriptive term "templates.com" is not warranted. Specifically, applicant insists in its initial brief that the Examining Attorney "erred in concluding [that] the proposed mark is not a unitary mark, thus requiring a disclaimer, when she based her decision on the finding that 'the colored blocks merely form a background for the wording, which does not qualify the proposed mark as a unitary mark.'" However, according to applicant, the test for determining whether a mark is unitary is "whether the mark creates a single and distinct commercial impression," citing *Dena Corp. v. Belvedere International, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991), in which the court listed the following factors from the TMEP to assist in making such a determination:

Whether it is physically connected to the mark by lines or other design features; how

close the matter is located to the mark and whether side by side on the same line; the meaning of the words and how the meaning relates to each other and to the goods

950 F.2d at 1561, 21 USPQ2d at 1052.

Based on such factors, applicant asserts that a disclaimer of the term "templates.com" is not required inasmuch as an examination of the mark as a whole "discloses that its elements are so merged together as to be regarded as indivisible and distinct." Applicant argues in this regard that (emphasis in original):

First, the wording TEMPLATES.COM is integrally intertwined with the design features of the Mark. Specifically, in the word "templates," each letter is encased by the design element of the Mark. Absent the design element, in fact, the letters would cease to exist as they are shown in the "negative," surrounded by the "positive" coloration of the design. Because the word "templates" is connected to, and created by, the design features of the mark, it is an "indivisible symbol rather than two divisible [elements]". *Id.* quoting *Kuppenheimer & Co[.] v. Kayser-Roth Corp.*, 326 F.2d 820, 822[, 140 USPQ 262, 263] (CCPA 1964).

Second, the Examiner's reliance on the finding of the existence of a background is insufficient by itself to support her conclusion that the Mark is not unitary. A greater and more in-depth analysis is required. In *Dena Corp.*, while the court considered the background, it found that it and the words EUROPEAN FORMULA were separable elements. *Id.* at 1561. However, in the proposed Mark, the background of colors, if it is a background, positively binds each letter that is contained in word "templates." Therefore, in the present case, the wording and the design are **in**separable elements.

Third, because the design element of the Mark is so intertwined with the wording, no potential purchaser would possible perceive

the Mark to convey separable impressions. Contrary, in *Dena Corp.*, the words EUROPEAN FORMULA were physically separated from the circular design element at issue. The same is not true here. In the present Mark, there is a complete melding of words and design.

The Examining Attorney, on the other hand, contends that applicant's mark is not unitary, observing in her brief that the mark "contains the wording TEMPLATES in white over a background design of different colored blocks, with the term .COM in gray to the right of the design." According to the Examining Attorney, because the wording is written over the background design and extends beyond such design, a disclaimer of the wording "templates.com" is appropriate. In particular, as to applicant's arguments, she notes among other things that:

[T]he term TEMPLATES is not carved out of a design of templates or other design that would merge the wording with the design. Rather, the term TEMPLATES is written across the backdrop of a series of colored blocks, with the term .COM written outside of the block design. Furthermore, the wording is all in the same font and perfectly aligned across the background design, rather than each term being carved out of each block, which would make the letters in the wording uneven. Consequently, the commercial impression of the mark is that the term TEMPLATES.COM is on top of the background design, making it separable.

....

As stated in *Dena Corp.*, a mark is unitary if the mark "has a distinct meaning of its own independent of the meaning of its constituent elements." *Id. at 1561.* Here, the proposed mark does not have an independent meaning apart from the descriptive wording TEMPLATES.COM combined with a colorful background design.

As stated in the Trademark Manual of Examining Procedure, §1213.05, a mark is

unitary if "the whole is something more than the sum of its parts." Here, the whole is not more than the sum of its parts. Rather, the mark is exactly the sum of its parts, the term TEMPLATES.COM and the background design for the term TEMPLATES.

While we agree with applicant, as reiterated in its reply brief, that the "colored blocks" or rectangles which constitute the design element of its mark are more than a mere "background design" as asserted by the Examining Attorney, we nonetheless concur with the Examining Attorney, as additionally stated in her brief, that "[h]aving wording on top of a design does not make the design 'so intertwined with the wording' that the mark is 'singular and inseparable,' as argued by the Applicant." Instead, we find that the term "templates.com" makes a separate and distinct commercial impression from the design element of applicant's mark, which serves as a vehicle for the display of such term, and thus that applicant's mark is not unitary. In particular, we fail to see how the "templates" portion of applicant's mark is so integrated with the colored blocks or rectangular design element as to be regarded by consumers as inseparable therefrom. Rather, just as the words "european formula" in *Dena Corp.* were likewise displayed in the "negative," that is, on a dark or "positive" background, and the mark therein as a whole was found not to be unitary, the same is true in this case, notwithstanding that the letters forming the term "templates" are superimposed over the colored blocks or rectangular design element in applicant's mark whereas the words "european formula" did not touch a separate design element in the mark involved in *Dena Corp.* Here, rather than being inseparable

as contended by applicant, the merely descriptive term "templates.com" stands out from the colored rectangles or blocks which constitute a vehicle for its display and thus such term conveys a separate and distinct commercial impression which is properly subject to a requirement for a disclaimer.

Decision: The requirement for a disclaimer under Section 6(a) is affirmed. Nevertheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of the merely descriptive term "templates.com."²

² See *In re Interco Inc.*, 29 USPQ2d 2037, 2039 (TTAB 1993); and TMEP §§1213.08(a)(i) and (ii) (5th ed. 2007).